



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,778	01/06/2001	Willy M. Balaba	223 BAL	3227

23774 7590 03/26/2003

DOUGLAS G GLANTZ  
ATTORNEY AT LAW  
5260 DEBORAH COURT  
DOYLESTOWN, PA 18901

EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

# Office Action Summary

Application No.

09/755,778

Applicant(s)

BALABA ET AL.

Examiner

Elizabeth M Cole

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-20 is/are rejected.
- 7) ☒ Claim(s) 4-5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1771

1. The terminal disclaimer filed on 12/19/02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,228,199 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 20 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 7 of prior U.S. Patent No. 6,228,199. This is a double patenting rejection.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1771

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, <sup>6-13</sup>14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klett, U.S. Patent No. 5,605,757 in view of Souders et al, U.S. Patent No. 5,395,108 and Dailey, Jr., U.S. Patent No. 5,075,414.

Klett discloses a pultruded product comprising a plurality of continuous glass fibers oriented substantially in the longitudinal direction, which have been contacted with a resin binder and pultruded to form a pultruded product. Klett teaches that the fibers may be treated with a size before they are formed into the pultruded product. Klett differs from the claimed invention because Klett does not teach employing a resorcinol modified phenolic resin binder and because Klett does not teach subjecting the pultruded product to an oxidative treatment. Dailey, Jr. discloses a resorcinol modified phenolic resin binder which can be employed to form fiber reinforced plastic products. Dailey, Jr. teaches that the resin enhances the fire resistance of fiber reinforced products. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the resin disclosed by Dailey, Jr. One of ordinary skill in the art would have been motivated to employ the resin disclosed by Dailey, Jr. because it would enhance the fire resistance of the pultruded product produced by Klett. With regard to the step of oxidative treating the pultruded product, Souders et al teaches that pultruded articles which are intended to be used as wood substitutes may be subjected to treatments such as sanding before the products are painted or otherwise finished. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed a

Art Unit: 1771

treatment on the pultruded product of Klett such as mechanically abrading the surface. One of ordinary skill in the art would have been motivated to abrade the surface in order to render the surface more receptive to finishing by painting, adhesive bonding, etc.

6. Applicant's arguments filed 12/19/02 have been fully considered but they are not persuasive.

Applicant argues that Klett does not teach passivation. However, this limitation is not found in the claims.

Applicant argues that the oxidative treatment disclosed in Souders is mechanical while the instant invention requires a chemical process. However, the claims recite "oxidative treated". The specification states at page 8, that the oxidative treatment may be physical or chemical, and states that a type of physical oxidative treatment is frictional rubbing. Therefore, since the claims are not limited to a chemical oxidative treatment, the rejection has been maintained.

Applicant argues that there is no motivation to combine the references. However, as set forth above, the motivation to employ the resorcinol-modified resin of Dailey because it would enhance the fire resistance of the pultruded product of Klett. The motivation to employ the sanding step, as set forth above, would have been to make the surface more easily painted, etc.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

Art Unit: 1771

invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As set forth above, the motivation to make the proposed combination is set forth above and is found in the prior art references themselves.

Applicant's review of pertinent case law and the claimed invention at pages 6-10 have been carefully considered. With regard to the article claims, no limitations concerning passivation, pre-coating the fibers with furfuryl alcohol, or auto-catalyzing the resin binder are recited in the product claims. Therefore, arguments that these limitations are not taught in the prior art are not persuasive since these limitations are not claimed. However, it is agreed that the prior art does not teach these limitations and article claims including these limitations would be allowable.

7. Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant is reminded to avoid possible statutory double patenting problems with regard to US 6,228,199.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 5:00 PM Monday through Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

Serial Number: 09/755,778

Page 6

Art Unit: 1771

The fax number for official faxes is (703) 872-9310. The fax number for official after final faxes is (703) 872-9311. The fax number for unofficial faxes is (703) 305-5436.

A handwritten signature in black ink, appearing to read "Elizabeth M. Cole".

Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

e.m.c

March 25, 2003